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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,424	07/27/2001	David Frederick Bantz	YOR920010452US1	8854

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EXAMINER	
HARRELL, ROBERT B	

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,424	BANTZ ET AL.	
	Examiner	Art Unit	
	Robert B. Harrell	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *see attached Office Action*.

1. Claims 1-31 are presented for examination.

2. The amendment filed 05/02/2005 could have been viewed as non-responsive (see paragraph 6 (last sentence) of examiner's prior Office Action)) since it failed to comply with paragraph 3 and paragraph 6. Specifically, Jini is a trademark as indicated in claim 7, 17, and 27 (for example) and yet Jini in the Specification (for example page 5 (line 12)) has not been so amended with "TM" and thus the Spcificaition is so objected to for lacking "TM" where required in the Specification. More so, numerous cases still lack for adequate antecedent bases such as, and not so limited, to claim 2 (line 4 "the location profile" (in the singular)), claims 8 and 18 ("the latency", "the arrival", and "the response"), claim 13 (line 6 "the unique location"), claim 21 (lines 1-2 "the portable data processing system"); and, so forth. Also, the paragraphs of the 05/02/2005 amendment to the specification do not match numerically. For example, paragraph 17 actually starts after "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT" with the phrase "With reference now to FIG. 1, a pictorial diagram of a networked data processing system" not so as in the amendment to the Specification;, page and line numbers would result in a more acurate insertion of the required amendments.

3. For the reasons set forth above, the applicant should use this period for response to thoroughly and very closely proof read and review *the whole of the application* for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks ™ , and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

4. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-31 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

6. Numerous cases still lack for adequate antecedent bases such as, and not so limited, to claim 2 (line 4 "the location profile" (in the singular)), claims 8 and 18 ("the latency", "the arrival", and "the response"), claim 13 (line 6 "the unique location"), claim 21 (lines 1-2 "the portable data processing system"); and, so forth, are but a few examples of numerous cases where clear antecedent bases are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent bases also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s).

Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent bases for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent bases are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short ***a few*** cases where clear antecedent bases are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent bases are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

7. Claims 7, 17, and 27, contain the trademark/trade name Jini TM. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Jini TM and, accordingly, the identification/description is indefinite.

8. The method claims are indefinite because they lack means for performing the recited steps. Also, the time sequence or order of performing these steps is lacking and uncertain. It cannot be ascertained which group(s) of step(s) is(are) performed prior to, after, or in parallel with another group(s) of step(s). This rejection was raised in paragraph 7 of examiner's prior Office Action and was not addressed by the applicant. Thus the rejection still stands.

27. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-31 are rejected under 35 U.S.C. 102 (b) as being anticipated by Norris (5,557,748).

10. The grounds for rejecting the claims under 35 U.S.C. 102(b), as presented in examiner's prior Office Action, continue and are hereby incorporated in this Office Action by reference.

11. The applicant argued the rejection by stating in substance that Norris fails to teach each and every element of the claim. Specifically the applicant argues:
a) the rejected claims recites, responsive to sufficiently matching the location syndrome to one of the set of location profiles, returning, to another software component, a label corresponding to a matched one of the set of location profiles as a current location of the portable data processing system." The feature of sufficiently matching the location syndrome to one of the set of location profiles is not taught by Norris. However, the word "sufficiently" is relative and any indication providing a positive result is only based so on the sufficiency of the data there provided to make a determination. Norris shows in figure 4 (470) a determination step where if a sufficient match is made a path to 475 is taken else a path to 480 is taken. Also, with step 470 and step 475, combined, a sufficient match was made to ascertain the location of the portable (mobile) computer;
b) Norris has no provisions to deal with the possibility that no exact match occurs despite the fact that the user is at a previously observed location. If a user is at a previously observed location, and all but one current participant is identical to the existing list for the previously observed location, Norris does not consider the current participants list to be a sufficient match. However, as indicated above, the method fails to recite who or what is performing the steps. Thus the user, in Norris, satisfies any requirements to make a sufficient match;
c) in contrast to the present invention, where the location determination process determines the location of a portable computer to a wide variety of differing degrees of confidence, in Norris the comparison either results in an exact match (100% confident) or no match (0% confident). Due to the lack of a sufficient match feature in Norris, the rejection fails. However, no established threshold has been established with the claimed invention. Such "confident" levels establish a binary threshold and score of absolute degrees of either "Yes" or "No" as claimed by the applicant in such claims as claims 2-5, for example; and,
d) Norris does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. However, the rejection is under 35 U.S.C. 102(b), and thus no suggestion of modification is required.

13. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896 . The fax phone number for all papers is (703) 872-9306.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142